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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,550	03/17/2004	Patrick Fogarty	TOSK-007CIPCON	5663
24353	7590	11/16/2006	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP			SGAGIAS, MAGDALENE K	
1900 UNIVERSITY AVENUE				
SUITE 200			ART UNIT	PAPER NUMBER
EAST PALO ALTO, CA 94303			1632	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/803,550	FOGARTY, PATRICK	
	Examiner Magdalene K. Sgagias	Art Unit 1632	
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
THE REPLY FILED 27 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.			
<p>1. <input checked="" type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>			
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<p>NOTICE OF APPEAL</p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>			
<p>AMENDMENTS</p> <p>3. <input type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).</p> <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____. </p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: <u>None</u>.</p> <p>Claim(s) objected to: _____.</p> <p>Claim(s) rejected: <u>11-15, 17, 18 and 27-38</u>.</p> <p>Claim(s) withdrawn from consideration: _____.</p>			
<p>AFFIDAVIT OR OTHER EVIDENCE</p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p>			
<p>REQUEST FOR RECONSIDERATION/OTHER</p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u></p> <p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____.</p>			
 DEBORAH CROUCH PRIMARY EXAMINER GROUP 1800/1030			

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that when they have demonstrated a pair of P-element transposase recognized insertion sequences, which is derived from the *Drosophila* fly, is able to integrate into the genome of mice there is no reason to believe why the genetic element of an organism from one phylum should not be capable of integrating into the genome of another organism and based on the standard methods for making transgenic animals it is reasonable to conclude that the methods could be extrapolated to other animals in a similar manner without undue experimentation. In response the instant claims are encompassing any non-human and non-*Drosophila* animal, however, art of making any transgenic animal is unpredictable and neither instant disclosure nor art of record provide any guidance to overcome art recognized unpredictability as discussed in the previous office actions dated 7/31/06 and 12/5/05. Therefore it is unpredictable if the methods would result in inserting an exogenous nucleic acid into the genome of a non-human and non-*Drosophila* animal as claimed other than mouse. Applicants argue the publications cited on unpredictability represent only a small fraction of the total number of publications demonstrating the successful generation of transgenic non-human and non-*Drosophila* animals. In response it is emphasized the art of record indicates several factors that have significant effects on transposition factor including the extensive variation in the extent to which transposase stimulates integration between different species and between different cell lines of the same species as discussed in the prior office actions dated 7/31/06 and 12/5/05. Applicants argue the rejection of claims 27-34 under 35 USC &103 the cited references do not teach or suggest the claim element of a "non-human and non-*Drosophila* animal or cells derived from the animal that have a P-element transposase recognized insertion sequences integrated into the genome. It is reiterated that Rio et al, p 29, 1st column, 2nd paragraph, discusses transposase expression may allow P element transposition in other species other than *Drosophila*.